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10/770,353	02/02/2004	Ganapathy Krishnan	122120-176046	7666
60172 7590 06/23/2010 SCHWABE, WILLIAMSON & WYATT, P.C. 1420 FIFTH, SUITE 3400 SEATTLE, WA 98101-4010				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/770,353

**Applicant(s)**

KRISHNAN ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-50, 58 and 65-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-50, 58 and 65-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicants papers filed on April 8, 2010 is hereby acknowledged.  
A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 18, 2009 has been entered.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 29-50, 58 and 65-78 drawn content usage with a "remote broker", classified in class 726 subclass 7.
  - II. Claims 51-57, 59-64 and 79-82 are drawn to usage protection of distributed files, classified in class 705 subclass 51.
3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the

subcombination as claimed. Invention II does not require the "remote licensing broker of Invention I.

4. Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper filed on April 8, 2010 a provisional election was made without traverse to prosecute the of Invention I, claims 29-50, 58 and 65-78. Affirmation of this election must be made by applicant in replying to this Office action. Claims 48-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claims 29-50, 58 and 65-78 have been examined.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 29-50 and 65-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose (US Patent No 5,708,709).

7. As per claims 29, 65 and 75,

Rose ('709) discloses a system for acquiring digital content, comprising:  
a processor configured to process instructions and to access a memory; (Column 7, lines 11-27)

8. Examiner notes that the manner in which a claimed apparatus is intended to be used (e.g. download one or more components of the digital content; authenticate the one or more components of the digital content; and store the one or more downloaded and authenticated components in an unusable form in the memory, wherein the digital-content-accessing component is further configured to be invoked by a selection interface provided by a digital content supplier; and a license component that is incorporated within a component of the digital content and that is configured to: communicate with a remote licensing broker to request a license certificate to the digital content. ) does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform(MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

9. Claims 30-50 and 66-74 and 76-78 are dependant upon the above rejected claims and are rejected or at least the same reasons.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

10. Claims 29-50, 58 and 65-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (US Patent No 5,708,709) in view of Coley et al. (US Patent 5,790,664).

As per claims 29, 42, and 75,

11. Rose ('709) discloses a system for acquiring digital content, comprising:  
a processor configured to process instructions and to access a memory; (Column 7, lines 11-27) a digital-content-accessing component that is configured to:  
a license component that is incorporated within a component of the digital content and that is configured to (Column 7, lines 8-26; Figure 9A) communicate with a remote licensing broker to request a license certificate to the digital content. (Column 7, lines 26-67; Column 9, lines 21-34). Rose ('709) does not explicitly disclose download one or more components of the digital content; authenticate the one or more components of the digital content; and store the one or more downloaded and authenticated components in an unusable form in the memory, wherein the digital-content-accessing component is further configured to be invoked by a selection interface provided by a digital content supplier;  
Coley et al. ('664) discloses download one or more components of the digital content; authenticate the one or more components of the digital content; and store the one or more downloaded and authenticated components in an unusable form in the memory, wherein the digital-content-accessing component is further configured to be invoked by a selection interface provided by a digital content supplier (Figure 2; Column 4, lines 41-48; column

9, lines 1-23; column 9, lines 42-51). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable the transaction to yield a useful product.

12. In regard to claims 29-50 and 75-78 The Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

13. As per claims 30, 67, 72 and 76  
Rose ('709) discloses the system of claim 29, wherein the selection interface is configured to be instantiated on the client computer to provide a description of the digital content; and to enable acquisition of the digital content from a remote digital- content vendor.(Figure 2, Column 3, lines 35-47)

14. As per claim 31 and 43  
Rose ('709) discloses the system of claim 30, wherein the selection interface includes at least one of:  
an executable file configured to display a graphical user interface; data received by the client computer to enable display of the graphical user interface; a web page displayed on the client computer by a browser application; and a text file stored on the client computer

that includes links or references to the digital content to enable access of the digital content by at least one or more of: an Internet browser, email, mail, telephone, fax, and a file transfer protocol application.(Column 3, lines 11-27; Column 4, lines 10-23; Figure 2)

15. As per claim 32, 45 and 73

Rose ('709) discloses the system of claim 29, wherein the digital content accessing component is an executable file configured to download the components of the digital content from remote computer systems.(Column 7, lines 1-26).

16. As per claims 33, 46 and 66

Rose ('709) discloses the system of claim 32, wherein the digital content-accessing component is transferred from a remote computer to the client computer through a communications medium.(Column 6, lines 40-44).

17. As per claim 34 and 47

Rose ('709) discloses the system of claim 32, wherein the digital- content-accessing component is generated locally on the client computer from a component list.(Column 6, lines 28-39).

18. As per claims 35, 69, and 74



Rose ('709) discloses the system of claim 29,  
wherein the digital- content-accessing component is further configured to:  
authenticate a received digital-content component by generating a message digest from the  
received digital-content component and comparing the generated message digest with a  
stored message digest. (Column 10, lines 30-42).

19. As per claim 36 and 48

Rose ('709) discloses the system of claim 29,  
the system of claim 29, wherein at least one received digital-content component is  
encrypted. (Column 5, lines 8-12; 44-52).

20. As per claim 37, 44 and 70

Rose ('709) discloses the system of claim 29,  
wherein the license component is further configured to: request an electronic license  
certificate from the remote licensing broker.(Column 7, lines 9-26; Column 9, lines 21-34).

21. As per claim 38

Rose ('709) discloses the system of claim 37,  
wherein the license component is further configured to:  
receive an electronic license certificate from the licensing broker and to decrypt encrypted  
received digital-content components.(Column 10, lines 4-29).

22. As per claim 39  
Rose ('709) discloses the system of claim 29,

Rose ('709) does not explicitly disclose wherein the license component is further configured to: execute a purchase transaction including a purchase of a license for the digital content. Coley et al. ('664) discloses wherein the license component is further configured to: execute a purchase transaction including a purchase of a license for the digital content. (Column 10, lines 6-27). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable the transaction to yield a useful product.

23. As per claim 40 and 49  
Rose ('709) discloses the system of claim 29,

wherein components of the digital content includes one or more of: an encrypted executable file; an encrypted data file; a user interface library; a purchasing request library; a security information file; and an electronic license certificate. (Column 5, lines 12-18; 44-52).

24. As per claim 41 and 50,  
Rose ('709) discloses the system of claim 29,

wherein the digital content includes one or more of: digitally encoded executable code; digitally encoded source code; a digitally encoded video program; a digitally encoded audio program; digitally encoded music; a digitally encoded game; a digitally encoded multi-media program; a digitally encoded movie; and a digitally encoded text

document.(Column 1, lines 13-19).

25. As per claims 58,

Rose ('709) discloses the system of claim 29,

wherein the license component is further configured to: receive the requested license certificate; and generate a useable form of the digital content from the one or more components of the digital content according to the received license certificate.(Column 10, lines 21-53)

26. As per claims 65 and 71,

Rose ('709) discloses a computer-readable storage medium with an executable program stored thereon, wherein the program instructs a client computer to perform steps enabling licensing of digital content, comprising:

communicating with a licensing broker to obtain a licensing certificate to at least the portion of the digital content; (Figure 9A; Column 7, lines 26-67).

Rose ('709) does not explicitly disclose storing at least a portion of the digital content in an unusable form on the client computer; and in response to the obtained licensing certificate, generating a useable form of at least the portion of the digital content from the stored unusable form. Coley et al. ('664) discloses storing at least a portion of the digital content in an unusable form on the client computer; and in response to the obtained licensing certificate, generating a useable form of at least the portion of the digital content from the stored unusable form. (Figure 2; Column 4, lines 41-48; column 9, lines 1-23;

column 9, lines 42-51; Column 14, lines 57-67). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rose ('709)'s teaching with the Coley et al. ('664) method in order to enable the transaction to yield a useful product. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed (e.g. in response to ...) or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

27. As per claims 68 and 77,

Rose ('709) discloses the computer-readable storage medium of claim 67, wherein the steps further comprise:

generating a digital-content-accessing component on the client computer from the digital content, and wherein the digital-content-accessing component is an executable file configured to: access and receive additional digital content from a remote computer system. (Column 3, lines 47-60; Column 8, lines 28-31).

28. As per claim 78,

Rose ('709) discloses the system of claim 75,

wherein the digital content vendor is a remote digital content vendor.(Figure 1).

### ***Conclusion***

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685